



Paper No. 7

HONEYWELL INTERNATIONAL, INC.
LAW DEPT. AB2
P.O. BOX 2245
MORRISTOWN, NJ 07962-9806

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In re Application of
Kenneth W. Henry et al.
Application No. 10/053,183
Filed: November 9, 2001
Attorney Docket No. 170-00-004

OFFICE OF PETITIONS

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:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
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This is in response to the petition under 37 CFR 1.47(a), filed on April 19, 2002.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on November 9, 2001, naming Kenneth W. Henry, James A. Rhoden and Todd Michael Inskeep as inventors but, without an executed oath or declaration.

Accordingly, on February 19, 2002, a "Notice To File Missing Parts of Application" was mailed, requiring an executed oath or declaration, and a surcharge for its late filing.

In response, on April 19, 2002, petitioner filed, *inter alia*, the instant petition under 37 CFR 1.47(a), the required petition fee and surcharge for late filing, and a declaration signed by joint inventors Henry and Inskeep.

Petitioners assert that joint inventor Rhoden is now deceased and that a known legal representative cannot be found or reached after diligent effort.

37 CFR 1.42 states, in part:

In the case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor, or legal representative thereof, cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The present petition lacks items (1), (2) and (4).

At the outset, petitioners are advised that 37 CFR 1.47 is not considered an alternative to 37 CFR 1.42 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor.¹ 37 CFR 1.42 states that when the inventor is dead, the legal representative may make the necessary oath or declaration. 37 CFR 1.47 will apply when a known legal representative cannot be found or refuses to sign the declaration. In such cases, the last known address of the legal representative must be established before the grant of a patent.² When petitioners initially filed this declaration and petition under 37 CFR 1.47(a), perhaps no legal representative for the deceased inventor, Rhoden, had been named. Presumably in the subsequent time period a legal representative has been named.

To establish 37 CFR 1.47 status, petitioner must submit a 37 CFR 1.47 petition on behalf of the legal representative of the deceased inventor.

In regards to item (1), the mere statement that the deceased joint inventor's widow had not been appointed the administrator/executor and that she was unaware of who or how to reach such administrator/executor, is insufficient to show that a diligent effort was made to locate Rhoden's legal representative. Where inability to find or locate a named inventor(s), or legal representative thereof, is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor or legal representative. The statement(s) of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay, will not normally be accepted. Petitioners should demonstrate that a thorough inspection of sources including, but not limited to, personnel or payroll records and probate filings. Petitioners should use diligent efforts to determine the current or last known address of the nearest living relative of the deceased inventor. Copies of the results of the search must be referred to in any renewed petition.³

Additionally, Rhoden's legal representative or heirs will have to be proffered the complete application papers (specification, including claims, drawings, if any, and the

¹In re Application Papers Filed September 10, 1954, 108 USPQ 340 (Comm'r Pat. 1955).

²See 37 CFR 1.42.

³See MPEP 409.03(d).

declaration) for signature.⁴ In the event that the legal representative or heirs refuse to sign the declaration, petitioners may provide proof that a copy of the application was sent or given to the legal representative for review by providing, with a renewed petition, a copy of the cover letter transmitting the application papers to the legal representative or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

In the event that Rhoden's legal representative refuses in writing to sign the declaration, petitioners should provide a copy of the written refusal with any renewed petition. If the refusal is made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (2), the oath or declaration must identify the name, residence, mailing address, and citizenship of the legal representative of the deceased inventor, and state that the legal representative is signing on behalf of the deceased joint inventor. A new oath or declaration in compliance with 37 CFR 1.63 and 1.64, containing the information described in this paragraph, is required.

In reference to item (4), above, the petition must include the last known address of the legal representative of the deceased joint inventor.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (703) 305-4497.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

⁴See also MPEP 409.01(a),(b); 409.03(c).